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EXAMINER

BROWN, RUEBEN M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/822,397
Filing Date: March 20, 1997
Appellant(s): SCHWAB ET AL.

MAILED

MAR 24 2004

Technology Center 2600

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/07/2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

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(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Claims 18-40 are rejected under 35 U.S.C. 112, 1st paragraph, instead of 2nd paragraph, as stated by the appellant.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 18-40 stand or fall together. Examiner disagrees with this statement. Claim 18 recites that the automatic switching to an alternate transmission medium is based on the information previously entered by the viewer. Whereas independent claims 26 & 34 recite that the automatic switching to a secondary or different transmission medium is due to additional information or a channel-change command, respectively, included in a video signal. Thus claims 18-25 stand as a group, while claims 26-40 stand as a different group.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The examiner in the rejection of the claims under appeal relies upon no prior art.

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Considering claim 18, the amended claimed feature of, “automatically switching the TV program to the alternative transmission based on the information previously entered by the viewer without requiring any additional viewer intervention at the time of switching”, does not find explicit support in the specification or original claims. Claims 19-25 depend from claim 18 and are likewise treated.

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Even though original claim 1 recites, “selectively route a TV program from any of the various inputs”, the claim does not require that the instant TV program be subsequently routed to or through a different input or transmission medium. Instead, original claim 1 recites that the instant TV program is routed “to the output for viewing on the display device.

Considering claim 23, the instant claim requires that the information for automatically switching the TV channel to an alternate transmission medium be downloaded from a computer. Therefore the claim 23 is analyzed in the same manner as claim 26.

Considering claim 26, the recited feature calls for, “transmitting, from a broadcaster to a viewing location, a TV program on a primary transmission medium, the program including additional information for directing the channel selector to automatically switch, at least temporarily, to one or more secondary transmission media”, which is not found in the specification.

On page 5 of the specification, it is disclosed that a primary channel may include additional information for directing a second tuner to a secondary channel. However, the specification does not explicitly state that in this instance, the secondary channel may be on a transmission medium different from the primary channel.

Furthermore, even though original claim 1 recites “selectively route a TV program from any of the associated inputs to the output for viewing on the display device”, the claim does not

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explicitly state that the same TV program is selectively routed from a first input to a second input. However, even if the original claim 1 had such a recitation, present claim 26 would still lack support from original claim 1. This is because the “switching” in original claim 1 is a “function of the user-defined channel designations”, which is different from the “switching” of present claim 26.

The instant claim 26 recites that the switching is due to, “the program including additional information for directing the channel selector to automatically switch, at least temporarily, to one or more transmission media”. Therefore even though both original claim 1 and present claim 26, recite switching, the switching in the two instant claims are caused by different events.

Claims 27-33 depend from claim 26, and are likewise treated.

Regarding claims 24 & 25, and 39-40, the amended claimed features require data transmitted continuously with a TV program or at the initiation of a TV program, which automatically switches the instant TV program from a first transmission medium, to an alternate transmission medium. Since claims 24 & 25 require that the switching to a different transmission medium is in response to transmitted data, instead of a user selection, the instant claims are treated in the same manner as claim 26.

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Considering claim 34, the instant claim requires that a channel change command included in a TV program is detected by equipment at a TV viewing location, and in response to the detected channel change command, a different transmission is selected. Therefore the recited features correspond with subject matter mentioned above in the rejection of claim 26 and are likewise treated. Again, examiner finds no disclosure in the specification or the original claims for a channel change command included in a TV program that causes a subscriber TV equipment to automatically change to a different transmission medium.

Claims 35-40 directly or indirectly depends from claim 34, and are likewise treated.

(11) *Response to Argument*

Appellant's arguments filed 1/7/2004 have been fully considered but they are not persuasive. Appellant argues that, 'clearly to one of ordinary skill in the art, channels on primary vs. secondary transmission media may be selected at will, without regard to origin'. Examiner agrees that the specification discloses that a user may select a channel from any of the various inputs, (i.e., cable, broadcast or satellite) at will, without regard to origin. However, the specification does not explicitly state that the invention enables automatic switching of channels from one transmission medium to a different transmission medium without user intervention.

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By way of example, on page 5, lines 18-23, the specification states, “a primary channel will typically carry ‘primary’ program information along with additional information used by the system for directing a second tuner to a secondary channel”. Notwithstanding this teaching, there is no disclosure that explicitly teaches that the additional information may be used to automatically switch the system, for instance, from the cable source to the satellite source or broadcast source, or vice versa.

With respect to claim 18, original claim 1 recites that that, “the switching of a particular input being a function of the user-defined channel designations”. *However, ‘being a function of is not the same as ‘without requiring any additional viewer intervention’.* The switching of the channel in original claim 1 could be a function of the user-defined channel designations and additional user interventions, or anything else for that matter, since the claim does not actually limit the switching to being ‘**only**’ a function of the user-defined channel designations. In other words, original claim 1 does not recite any exclusionary language that restricts the switching from being a function of the user-defined channel designations and any other criteria.

Thus, the relevant subject matter of claim 18 is narrower than the relevant subject matter of original claim 1, since claim 1 does not explicitly state the switching is executed ‘without requiring any additional viewer intervention’. Claim 18 adds a feature, namely, ‘without requiring any additional viewer intervention’, that is not found in or supported by original claim 1.

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Again, while original claim 1 does recite, “selectively route a TV program from any of the various inputs”, the instant claim does not state that the instant TV program is subsequently routed to or through a different input or transmission medium. Instead, original claim 1 recites that the instant TV program is routed “to the output for viewing on the display device”.

Furthermore, even though the claim recites, “the switching of a particular input being a function of the user-defined channel designations”, there is no specific recitation as to how the selective routing of the TV program relates to the switching of a particular input. And certainly there is no explicit recitation that states a TV program on a first transmission medium is switched (e.g., selectively routed) to a second transmission, different from the first transmission medium.

With respect to claims 23-26, 34 & 39-40, the originally filed claim 1 recites, “assign and re-assign user defined channels designations to channels present on any of the associated inputs, and store the designation for future use, and selectively route a TV program from any of the associated inputs to the output for viewing on the display device, the switching of the particular input being a function of the user defined channel designations”. Thus, examiner finds no basis in the above recitation, for the presently claimed feature of, “transmitting from a broadcaster to the viewing location, a TV program on a primary transmission medium the program including additional information for directing the channel selector to automatically switch, at least temporarily, to one or more secondary transmission media”, as recited in claim 26, and similarly recited in claims 23-25, 34 & 39-40.

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Furthermore, examiner points out that original claims 8 & 16, recite automatically determining at least one additional channel to be output along with its supplemental information, by receiving a code that contains the additional channel information. However, there is no recitation in these claims that the additional channel may be received over a different transmission medium from the main TV program of original claim 1.

Appellant also points to page 3, lines 3-10 of the specification, which states, "In a preferred embodiment, the unit may be provided with additional tuner provisions associated with any of the various inputs, for receiving signals in which a primary signal is one channel, and a secondary signal is on a different channel, as for example, in the case of a stereoscopic broadcast system in which one channel carried the "left eye" signal and a second channel carried the "right eye" signal".

However this disclosure does not explicitly state that the primary and secondary (signals) channels may be carried on different transmission medium (i.e. inputs). For example, the above-cited portion of the specification, page 3, lines 3-10, may be read thusly. Each of the various inputs are enabled to support the stereoscopic technology, so that a primary channel will carry the "left eye" signal, while the secondary channel carries the "right eye" signal, with both the primary channel and secondary channel being received over the same transmission medium, (i.e., input).

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In particular, page 3, line 4 discloses, “additional tuner provisions”, but does not explicitly define the feature. For instance, “additional tuner provisions” reads on multiple tuners for each input, which would support the example discussed above of tuning and receiving the two stereoscopic channels being received on the same transmission medium.

Examiner asserts that notwithstanding appellant’s argument, it is not inherent that a channel change command used to automatically change a tuner to a different channel on a particular input or transmission medium would also control the system (e.g. tuners) on a different transmission medium. For instance, tuning of TV programs using the analog transmission medium of Broadcast TV (i.e., UHF & VHF) is not the same as tuning of TV programs using satellite TV or broadband transmission generally found in CATV. Therefore the technology required to tune TV programs on a single transmission medium, is not as involved as switching over to a different transmission medium, using a different transmission algorithm and then tuning to a TV program.

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For the above reasons, it is believed that the rejections should be sustained.

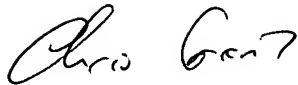
Respectfully submitted,

Reuben M. Brown
Examiner
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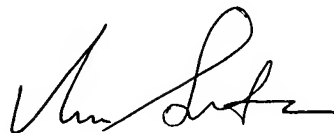
March 22, 2004

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